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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,296	01/10/2006	Philip Steven Newton	NL 030819	7969
24737 7590 12/15/2009 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
TEKLE, DANIEL T				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/564,296

**Applicant(s)**

NEWTON ET AL.

**Examiner**

DANIEL TEKLE

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 02, 2009 has been entered.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1-16 have been considered but are moot in view of the new ground(s) of rejection.

### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A **“computer readable program”** not claimed as **“embodied in and executed by a computer-readable medium”** is descriptive material per se and is not statutory because it is not capable of causing functional change in the computer. Such claimed data structures do not define any structural and functional interrelationships with the

other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed “ **computer readable medium encoded with a computer program when executed comprising**” defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the functionality to be realized, and is thus statutory.

Claim 15-16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The “computer-readable medium” can broadly interpret to include signal which is non-statutory subject matter.

“In the state of the art, transitory signals are commonplace as a medium for transmitting computer instruction and thus, in the absence of any evidence to the contrary and give the broadest reasonable interpretation, the scope of a “computer readable medium” covers a signal per se.”

In order to overcome this rejection examiner suggest replacing “computer-readable medium” with “non-transitory computer-readable medium”

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-16 rejected under 35 U.S.C. 102(e) as being anticipated by Swenson et al. (US 6,064,380).

**Regarding Claim 1:** Swenson et al. discloses an apparatus for recording comprising: means for receiving a source signal having associated first play time information; means for generating a recorded signal from the source signal (**column 1 lines 65-67 and column 5 lines 44-51**); the recorded signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal (**column 1 lines 65-67 and column 4 lines 62-67**); and means for generating second time information for the recorded signal in response to the first play time information and the recording discontinuity (**column 5 line 24**).

**Regarding Claim 2:** Swenson et al. discloses apparatus for recording as claimed in claim 1 wherein the second time information comprises markers indicating events in the recorded signal (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 3:** Swenson et al. discloses apparatus for recording as claimed in claim 2 wherein the second time information comprises a play list comprising the markers (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 4:** Swenson et al. discloses apparatus for recording as claimed in claim 1 wherein the second time information comprises event descriptors (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 5:** Swenson et al. discloses apparatus for recording as claimed in claim 4 wherein the means for generating the second time information is operable to

generate time information of the event descriptors by modifying time information of event descriptors associated with the source signal (**column 4 line 62 to column 5 line 24 and fig. 4**).

**Regarding Claim 6:** Swenson et al. discloses apparatus for recording as claimed in claim 5 wherein the means for generating the second time information is operable to generate the time information of the event descriptors by compensating the time information of event descriptors associated with the source signal by a time gap associated with the recording discontinuity (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 7:** Swenson et al. discloses apparatus for recording as claimed in claim 5 wherein time information of the event descriptors comprise relative time information associated with a play time line (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 8:** Swenson et al. discloses apparatus for recording as claimed in claim 5 further comprising means for extracting the event descriptors associated with the source signal from a transport signal comprising the source signal (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 9:** Swenson et al. discloses apparatus for recording as claimed in claim 4 wherein the event descriptor comprises a stream event comprising information for triggering an application (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 10:** Swenson et al. discloses apparatus for recording as claimed in claim 1 wherein the first play time information comprises a first play time line and the means for generating the second time information is operable to generate a non-

continuous play time line associated with the recorded signal and having a time discontinuity corresponding to the recording discontinuity (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 11:** Swenson et al. discloses apparatus for recording as claimed in claim 1 wherein the source signal and the recorded signal comprise Multimedia Home Platform (MHP) data (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 12:** Swenson et al. discloses apparatus for recording as claimed in claim 1 wherein the source signal and the recorded signal comprise Digital Video Broadcast (DVB) data (**column 4 line 62 to column 5 line 24**).

**Regarding Claim 13-16:** Claim 13-16 are rejected for the same subject matter as claim 1 discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/  
Supervisory Patent Examiner, Art Unit 2621

/Daniel Tekle/  
Examiner, Art Unit 2621